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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,150	07/15/2003	Paul Chen	13858 B	1213

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EXAMINER

MATHEW, FENN C

ART UNIT PAPER NUMBER

3764

DATE MAILED: 07/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/621,150	CHEN, PAUL	
	<b>Examiner</b>	<b>Art Unit</b>	
	Fenn C. Mathew	3764	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on 15 July 2003.

2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) 1-15 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 1-5 and 11-15 is/are rejected.

7) ☒ Claim(s) 6-10 is/are objected to.

8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) ☒ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on 15 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All    b) ☐ Some \*    c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 07/15/03.

4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☒ Other: foreign reference translation.

## DETAILED ACTION

### *Specification*

1. The disclosure is objected to because of the following informalities: On page 1 of the specification, the word 'pending' should be deleted, and --now U.S. Patent 6,656,093-- should be inserted therein.

Appropriate correction is required.

### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4 and 11-14 are rejected under the judicially created doctrine of obviousness-type double patenting as unpatentable over claim 2 of U.S. Patent No. 6,656,093 and claim 15 is rejected under the judicially created doctrine of obviousness-type double patenting as unpatentable over claim 3 of U.S. Patent No. 6,656,093. For double patenting to exist as between the rejected claims and patent claim 2 and 3 respectively, it must be determined that the rejected claims are not patentably distinct from claims 2 and 3. In order to make this determination, it first must be determined

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whether there are any differences between the rejected claims and claims 2 and 3 and, if so, whether those differences render the claims patentably distinct.

Claim 1 recites "a handle including a first end" (see line 2 of patent claim 1), "a plurality of weights each including a channel formed therein to slidably and selectively receive said first end of said handle" (see line 3, line 6-7, and line 13 of patent claim 1), "a latch slidably engaged onto said first end of said handle, and slidably and slidably engageable into said channels of a selected number of said weights respectively" (see lines 5-8 and lines 12-14 of patent claim 1), and "means for securing said latch to said first end of said handle, and to secure the selected number of said weights to said first end of said handle" (see lines 16-23)

Claim 2 further recites "each of said weights includes a groove formed therein and communicating with said channel thereof, to slidably receive said first end of said handle" (see lines 9-10 and 13-14 of patent claim 1).

Claim 3 further recites "the grooves of said weights include a width smaller than that of the channel to slidably receive said first end of said handle, said latch includes a width greater than that of said grooves of said weights" (see lines 13-16 of patent claim 1).

Claim 4 recites the securing means includes one beam attached to the first end of said handle, and means for catching said latch to said at least one beam of said first end of said handle" (see patent claim 1, lines 16-18 and 24-26. Note that limitations drawn towards the end of the handle including a conduit and passages for receiving the latch correlate to the 'beam attached to the first end').

Claim 11 recites "the at least one beam includes a passage formed therein, said securing means includes a rod secured to said latch and slidably engaged in said passage of said at least one beam" (see patent claim 1, lines 20-22).

Claim 12 recites "catching means includes a catch slidably engaged onto said rod for engaging with said at least one beam, to catch and secure said latch to said at least one beam" (see patent claim 1, lines 25-27).

Claim 13 recites "means for biasing said catch to engage with said at least one beam, and to catch and secure said latch to said at least one beam" (see patent claim 2, lines 2-3).

Claim 14 recites "the first end of said handle includes a passage formed therein to slidably receive said latch therein" (see lines 16-17 of patent claim 1)

It is clear that all the elements of claims 1-4 and 11-14 are to be found in claim 2 (as it encompasses claim 1). The difference between claims 1-4 and 11-14 of the application and claim 2 of the patent lies in the fact that the patent claim includes many more elements and is thus much more specific. Thus the invention of claim 2 of the patent is in effect a "species" of the "generic" invention of claims 1-4 and 11-14. It has been held that the generic invention is "anticipated" by the "species". See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since claims 1-4 and 11-14 are anticipated by claim 2 of the patent, it is not patentably distinct from claim 2.

Claim 15 recites "said handle includes a second end, and a plurality of second weights selectively secured to said second end of said handle" (see lines 2-7 of patent claim 3)

It is clear that all the elements of claim 15 are to be found in claim 3 (as it encompasses claim 1). The difference between claim 15 of the application and claim 3 of the patent lies in the fact that the patent claim includes many more elements and is thus much more specific. Thus the invention of claim 3 of the patent is in effect a "species" of the "generic" invention of claims 15. It has been held that the generic invention is "anticipated" by the "species". See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since claim 15 is anticipated by claim 3 of the patent, it is not patentably distinct from claim 3.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 4-5, 11, and 14-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Fomichenko (SU 1618430). Referring to claim 1, as broadly claimed, Fomichenko discloses an adjustable dumbbell assembly comprising a handle (1) inherently including a first end, a plurality of weights (18) including a channel formed therein (as seen in fig. 1) to slidably and selectively receive the first end of the handle (note (16) constitutes an end of the handle), a latch (2, 3) slidably engagable into the

channels of a selected number of the weights respectively, and means for securing the latch (11, 14) to the first end of the handle, and to secure the selected number of the weights to the first end of the handle. Referring to claim 4, as broadly claimed and interpreted, Fomichenko teaches a the securing means including at least one beam (13) attached to the first end of said handle, and means (10) for catching said latch (2, 3) to said at least one beam of said first end of said handle. Referring to claim 5, as broadly claimed, Fomichenko discloses a block (16) secured to the first end of the handle and the beam (via the latch). Referring to claim 11, as broadly claimed Fomichenko discloses at least one beam including a passage (see fig. 2), the securing means including a rod (12) secured to the latch, and slidably engaged in the passage of the beam. Referring to claim 14, Fomichenko discloses the first end of the handle including a passage formed therein to slidably receive the latch therein. Referring to claim 15, Fomichenko discloses the handle including a second end, and a plurality of second weights selectively secured to the second end of the handle.

***Allowable Subject Matter***

5. Claims 6-10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art of record fails to teach the particulars of the dumbbell as substantially claimed including the block having a cavity to receive an end portion of the beam, the plate received in the block, the handle extension, and plurality of projections.

**Conclusion**

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Krull (U.S. 6,669,606) and Cooper (U.S. 5,344,375) teach barbell/dumbbell apparatuses including weights having a channel, but failing to teach a slidable latch as substantially claimed. Martinez (U.S. 5,484,367) provides an example of a barbell with a means to prevent rotation of the weights.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fenn C. Mathew whose telephone number is (571) 272-4978. The examiner can normally be reached on Monday - Friday 9:00am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Huson can be reached on (571) 272-4887. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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A handwritten signature in black ink, appearing to read 'Fenn C. Mathew'.

Fenn C. Mathew  
July 23, 2006